

## **REMARKS**

Claims 1-7 are now pending in the application. Pending claims 1-7 stand rejected under 35 U.S.C. § 102 (e). The following remarks are considered by Applicants to overcome each rejection raised by the Examiner and to place the application in condition for allowance. An early Notice of Allowance is therefore requested.

### **I. Rejection Of Pending Claims 1-4 and 7 Under Double Patenting**

The Examiner provisionally rejects claims 1-4 and 7 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 9 of copending application No. 10/387,739. The Examiner claims that although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap the published claims and thus would be rendered obvious.

Since this is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented, Applicants respectfully submit that Applicants will not address the issue of a Terminal Disclaimer until subject matter is allowed by the Examiner.

### **II. Rejection Of Pending Claims 1-7 Under 35 U.S.C. § 102 (e)**

The Examiner has rejected claims 1-7 under 35 U.S.C. § 102 (e) as being anticipated by Koga et al., U.S. Patent Application Serial No. 10/387,739, filed March 13, 2003 and published September 25, 2003 ("Koga") with a U.S. Publication No. 2003/0179268. Applicants respectfully traverse this rejection.

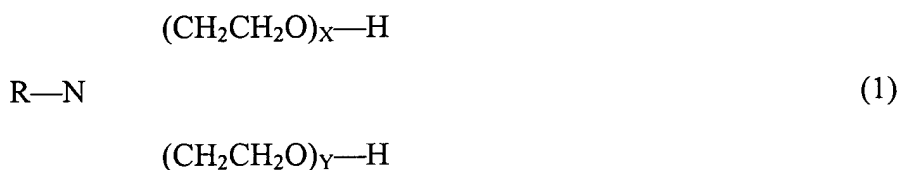
#### **A. Relevant Law**

"A claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference." *Bristol-Myers Squibb v. Ben Venue*, 246 F.3d 1368, 1374 (Fed. Cir. 2001). Identity of invention requires that a prior reference disclose to one of ordinary skill

in the art all elements and limitations of the patent claim. *Scripps Clinic v. Genentech*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). Absence from the reference of any claimed element negates anticipation. *Kloster Speedsteel AB v. Crucible, Inc.*, 230 USPQ 81 (Fed. Cir. 1986).

**B. Summary of Cited References**

Koga discloses a water based ink for ink-jet recording containing a surfactant represented by the following formula (1) or (2), dipropylene glycol, a coloring agent, and water:



wherein R represents alkyl group and x and y represent integers which satisfy  $x+y=5$  to 15 in the formula (1);



wherein z represents an integer of not more than 9 in the formula (2).

**C. Argument**

The Koga reference is not a prior art reference under 35 U.S.C. §102 (e)(1). As such, the Examiner has improperly rejected claims 1-7 under 35 U.S.C. § 102 (e) as being anticipated by Koga.

35 U.S.C. §102 (e)(1) states the following:

A person shall be entitle to a patent unless—  
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent...

Applicants' date of invention is at least August 19, 2002 - the date when its Japanese priority application was filed. A copy of the English translation of Japanese Application No. JP2002-238520 is attached with a statement from the translator that states that the translation of the

certified copy is accurate. Please note that Applicants have previously filed a certified copy of the Japanese Application No. JP2002-238520 on August 19, 2003, the date when this application was filed. This invention date of at least August 19, 2002, is prior to Koga's US filing date of March 13, 2003. As such, Koga does not qualify as prior art and a withdrawal of the Examiner's rejection under 35 U.S.C. §102 (e) based on this reference is appropriate.

### **III. Rejection Of Pending Claims 1-6 Under 35 U.S.C. § 102(e)**

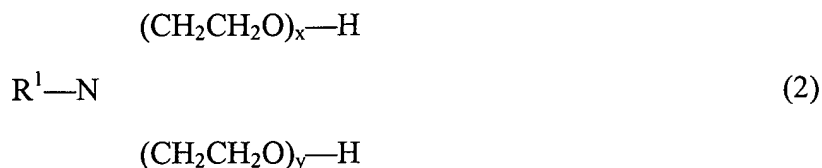
Claims 1-6 stand as rejected under 35 U.S.C. § 102 (e) as being anticipated over Sago et al., U.S. Patent Application Serial No. 10/385,511, filed March 12, 2003 and published September 18, 2003 ("Sago") with a U.S. Publication No. 2003/0174193. Applicants respectfully traverse this rejection.

#### **A. Relevant Law**

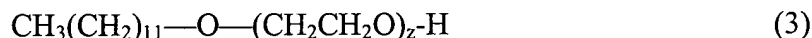
"A claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference." *Bristol-Myers Squibb v. Ben Venue*, 246 F.3d 1368, 1374 (Fed. Cir. 2001). Identity of invention requires that a prior reference disclose to one of ordinary skill in the art all elements and limitations of the patent claim. *Scripps Clinic v. Genentech*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). Absence from the reference of any claimed element negates anticipation. *Kloster Speedsteel AB v. Crucible, Inc.*, 230 USPQ 81 (Fed. Cir. 1986).

**B. Summary of Cited References**

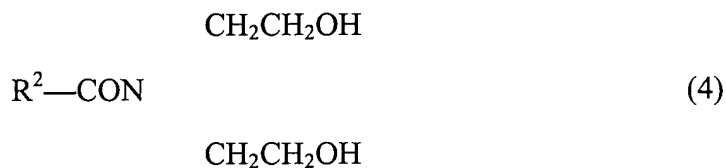
Sago discloses a water based ink for ink-jet recording containing an amine compound selected from the group consisting of N-n-butylethanolamine, 1,4-bis(3-aminopropyl)piperazine, benzylamine, and an amine compound represented by the following general formulas (2), (3), and (4):



wherein R<sup>1</sup> represents alkyl group and x and y are integers to satisfy x+y=5 to 15 in the formula (2);



wherein z is an integer of not more than 9 in the formula (3); and



wherein R<sup>2</sup> represents alkyl group in the formula (4), a structural formula, a coloring agent, and water.

**C. Argument**

The Sago reference is not a prior art reference under 35 U.S.C. §102 (e)(1). As such, the Examiner has improperly rejected claims 1-6 under 35 U.S.C. § 102 (e) as being anticipated by Sago.

35 U.S.C. §102 (e)(1) states the following:

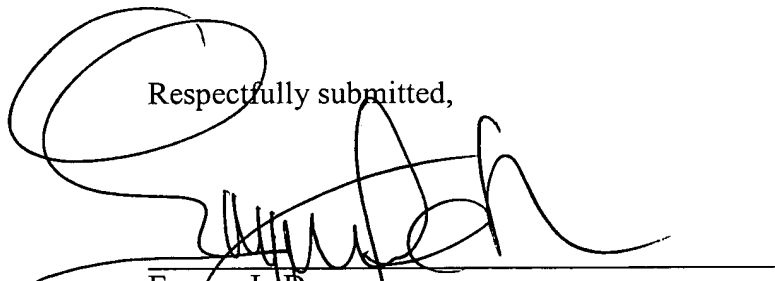
A person shall be entitle to a patent unless—  
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent...

Again, Applicants' date of invention is at least August 19, 2002 - the date when its Japanese priority application was filed. As stated above, a copy of the English translation of Japanese Application No. JP2002-238520 is attached with a statement from the translator that states that the translation of the certified copy is accurate. Applicants have previously filed a certified copy of the Japanese Application No. JP2002-238520 on August 19, 2003 the date when this application was filed. This invention date of at least August 19, 2002, is prior to Sago's US filing date of September 18, 2004. As such, Sago similarly does not qualify as prior art and a withdrawal of the Examiner's rejection under 35 U.S.C. §102 (e) based on this reference is appropriate.

**VI. Conclusion**

For the reasons presented above, claims 1-7, all the claims pending in the application, are believed by Applicants to define patentable subject matter and should be passed to issue at the earliest possible time. A Notice of Allowance is requested.

Respectfully submitted,

A large, stylized handwritten signature in black ink, appearing to read 'Eugene LeDonne', is written over a horizontal line.

Eugene LeDonne  
Reg. No. 39,930

REED SMITH LLP  
599 Lexington Avenue  
New York, NY 10022  
(P) 212-521-5402

Attorney for Applicant